7217/60188

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Fumitake YODO

Serial No.: 09/600,509

Filed : July 17, 2000

For : TERMINAL DEVICE, ACCOUNTING
SYSTEM AND DATA PROCESSING
METHOD

Group : 3627

Examiner : Andrew J. Fischer

January 17, 2006
1185 Avenue of the Americas
New York, NY 10036
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TRANSMITTAL LETTER FOR APPELLANT'S AMENDED BRIEF

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Commissioner for Patents
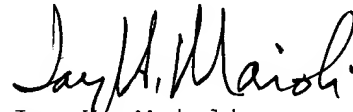P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

        Transmitted in triplicate is Appellant's Appeal

Brief in the above-identified application.

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The fee of $500.00 set by 37 C.F.R. § 41.20(b) for filing the Brief is submitted herewith.

Please charge any additional fees are incurred by reason of the Brief or credit any overpayment to the Deposit Account No. 03-3125. A duplicate of this Transmittal Letter is enclosed.

Respectfully submitted,

COOPER & DUNHAM LLP

Jay H. Maioli
Reg. No. 27,213

JHM/JBG
enc.

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Reg. No. 27,213   January 17, 2006

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APPELLANT'S BRIEF

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Sir:

     This is an Appeal to the Board of Patent Appeals and

Interferences from the Decision dated September 12, 2005, of

the Examiner finally rejecting claims 1, 4, 5 and 7 pending in

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this application.

1. REAL PARTY IN INTEREST

This application is assigned to Sony Corporation, 7-35 Kitashinagawa 6-chome, Shinagawa-ku, Tokyo 141, Japan by the Assignment recorded July 17, 2000 at Reel 010981, Frame 0857.

2. RELATED APPEALS AND INTERFERENCES

U.S. Application No. 09/923,702, filed August 7, 2001, being a divisional application of the instant application, is presently being appealed. A Notice of Appeal was filed on November 22, 2004 and an Appeal Brief was filed on February 22, 2005.

3. STATUS OF CLAIMS

This application was originally filed with 12 claims. Claims 1 and 3-7 were amended and claims and claims 2 and 7-12 were canceled by the Amendment mailed April 17, 2002. Claims 1 and 4-7 were amended and claim 3 was canceled by the Amendment mailed August 15, 2002. Claims 1, 4, 5, and 7 were amended and claim 6 was canceled by the Amendment mailed March 13, 2003. Claims 1 and 4 were amended by the Amendment mailed July 30, 2003. Claim 1 was amended by the Amendment mailed February 20, 2004. Claim 1 was amended by the Amendment mailed June 18, 2004. Claim 1 was amended by the Amendment mailed June 10, 2005. A Final Office Action was mailed on

September 12, 2005 finally rejecting claims 1, 4, 5, and 7.

Claims 1, 4, 5, and 7 stand finally rejected and are the basis

of this Appeal.

4.   STATUS OF AMENDMENTS

A Final Office Action was mailed on September 12, 2005

finally rejecting claims 1, 4, 5, and 7. Claims 1, 4, 5, and

7 stand finally rejected and are set forth in The Claims

Appendix attached hereto.

5.   SUMMARY OF CLAIMED SUBJECT MATTER

The invention presently claimed in independent claim 1

relates to an accounting system including an accounting center

and a terminal device for communicating with the accounting

center, including:

a first memory (45 in Fig. 3) built in the terminal

device (10 in Fig. 2) and adapted to store accounting point

information (Page 15, lines 16-17);

a second memory (15 in Fig. 3) included in the terminal

device and adapted to store information received from an

external source external to the terminal device (Page 16,

lines 1-11);

a first controller (11 in Fig. 3) included in the

terminal device and adapted to update the accounting point

information stored in the first memory and to update

attributes of the received information when the received information is stored in the second memory (Page 15, lines 19-21),

wherein when the received information is stored into the second memory the first controller reduces the accounting point information stored in the first memory and updates the attributes of the received information from an unavailable state to an available state (Page 15, lines 19-21 and page 31, lines 15-18); and

a second controller (19 in Fig. 3) included in the terminal device and adapted to transmit the remaining accounting point information stored in the first memory to the accounting center and to set the remaining accounting point information to an initial value based on an accounting processing status received by the terminal device from the accounting center corresponding to the remaining accounting point information, wherein the accounting center performs an accounting process based on the remaining accounting point information transmitted from the terminal device (Page 32, lines 17-21).

6.   GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Whether claims 1, 4, 5, and 7 are patentable under 35 U.S.C. § 103(a) over Peterson Jr., in view of Kupka et al., Akiyama et al., and White's How Computer's Work.

7.   ARGUMENT

CLAIMS 1, 4, 5, AND 7 ARE PATENTABLE UNDER 35 U.S.C. §
103(A) OVER PETERSON JR., IN VIEW OF KUPKA ET AL., AKIYAMA ET
AL., AND WHITE'S HOW COMPUTER'S WORK.

As described above in the "SUMMARY OF CLAIMED SUBJECT
MATTER" section of this Brief, features of the claimed
invention are a second controller included in a terminal
device for transmitting a remaining accounting point
information stored in a first memory built in the terminal
device to an accounting center which performs an accounting
process based on the remaining accounting point information
transmitted from the terminal device.

It is respectfully submitted that the combination of
Peterson Jr., in view of Kupka et al., Akiyama et al., and
White's How Computer's Work fails to show or suggest the
above-noted features of the present invention for the
following reasons.

Peterson Jr. fails to show or suggest a second controller
included in a terminal device for transmitting a remaining
accounting point information stored in a first memory built in
the terminal device to an accounting center which performs an
accounting process based on the remaining accounting point
information transmitted from the terminal device.

Peterson Jr. is merely teaching the use of a general

prepaid card (88 in Fig. 3) which inherently does not transmit remaining accounting points to an accounting center. As described in col. 9, lines 48-53 of Peterson Jr., it is merely possible to add (adjust) accounting points to the prepaid card by having the user physically take the prepaid card to a service center to add points to the card or by accessing the service center online ("online process").

Further, Peterson Jr. is clearly describing the use of a smart card (88 in Fig. 3) as an alternative to an online payment process, see col. 3, lines 3-5, and the purpose of either payment system is to enable a user to purchase the right to view a movie for a certain fee. Neither the smart card nor the online payment process of Peterson Jr. transmits the remaining accounting points to the accounting center.

Furthermore, the Examiner contends, in the Office Action of September 12, 2005, at paragraph 11, that the "configured to" language is considered functional language having no patentable weight, it is submitted that the C.C.P.A. has pointed out that there is nothing intrinsically wrong in defining something by what it does rather that what it is, and that functional language in the claims must be given full weight and may not be disregarded in evaluating the patentability of the subject matter defined employing such functional language. See In re Hallman, 210 U.S.P.Q. 609, 611 (C.C.P.A. 1981).

Moreover, as stated in MPEP Sec. 2173.05(g), a functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient or step.

For example, in a claim that was directed to a kit of component parts capable of being assembled, the court held that limitations such a "members adapted to be positioned" serve to precisely define present structural attributes of interrelated component parts of the claimed assembly, <u>In re</u> <u>Venezia</u>, 189 USPQ 149 (CCPA 1976).

It is respectfully submitted that, if the statement set forth in the Office Action at paragraph 11 asserting that "if the prior art structure is <u>capable</u> of performing the intended use, then it meets the claim" was true, all inventions being implemented in a general computer would be unpatentable over a reference showing the structure of the general computer. This is clearly not the case.

Moreover, there are no features in Kupka et al., Akiyama et al., and White's <u>How Computer's Work</u> that somehow could be combined with Peterson Jr. and result in the presently claimed invention.

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Kupaka et al. relates to a system for payment of downloaded electronic content to a storage medium. Electronic content is downloaded for a fee to the storage medium. The fee is deducted from a predetermined prepaid value.

Akiyama et al. relates to a security enhancement for an electronic cashless transaction system. An authentication key is controlled for proper operation of a money dispensing ATM.

White's How Computer's Work has been cited to show that a modem is old and well known in the art.

Assuming, arguento, that Peterson Jr. could be combined with Kupka et al., Akiyama et al., and White's How Computer's Work, the combination would still fail to show or suggest a second controller included in a terminal device for transmitting a remaining accounting point information stored in a first memory built in the terminal device to an accounting center which performs an accounting process based on the remaining accounting point information transmitted from the terminal device. This is because, while White's How Computer's Work may arguably show, as the Examiner suggests, that a modem may be connected to a computer, White's How Computer's Work fails to teach or suggest that a modem may be included in a terminal device for transmitting accounting point information stored in a first memory built in the terminal device to an accounting center. While Akiyama et al. may show, as the Examiner suggests, the storing of prepaid

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accounting points on a smart card, Akiyama et al. fails to teach or suggest that accounting point information may be stored in a first memory built in the terminal device. While Kupaka et al. may show that, as the Examiner suggests, that when a balance associated with "a media's unique identifier is less than the cost of the content to be downloaded" that the user may be prompted with an "error message" asking if the user would like to replenish (Kupaka et al., Col 17, lines 47-60), Kupaka et al. fails to teach or suggest terminal device for transmitting a remaining accounting point information stored in a first memory built in the terminal device to an accounting center which performs an accounting process based on the remaining accounting point information transmitted from the terminal device. In light of the above, the cited art, taken alone or in combination, fails to teach or suggest the present invention.

Accordingly, it is respectfully submitted that claims 1, 4, and 5 are patentable distinct over Peterson Jr. in view of Kupka et al., Akiyama et al., and White's How Computer's Work.

Accordingly, it is respectfully submitted that claims 1-18 are patentable under 35 U.S.C. § 103(a) over Peterson Jr., in view of Kupka et al., Akiyama et al., and White's How Computer's Work.

A reversal of the Final Rejection of claims 1, 4, 5 and 7 by this Honorable Board is respectfully requested.

Respectfully submitted,
COOPER & DUNHAM LLP

Jay H. Maioli
Reg. No. 27,213

JHM/JBG

8. CLAIMS APPENDIX

Claim 1. An accounting system including an accounting
center and a terminal device for communicating with the
accounting center, comprising:

a first memory built in the terminal device and adapted
to store accounting point information;

a second memory included in the terminal device and
adapted to store information received from an external source
external to the terminal device;

a first controller included in the terminal device and
adapted to update the accounting point information stored in
the first memory and to update attributes of the received
information when the received information is stored in the
second memory,

wherein when the received information is stored into the
second memory the first controller reduces the accounting
point information stored in the first memory and updates the
attributes of the received information from an unavailable
state to an available state; and

a second controller included in the terminal device and
adapted to transmit the remaining accounting point information
stored in the first memory to the accounting center and to set
the remaining accounting point information to an initial value
based on an accounting processing status received by the
terminal device from the accounting center corresponding to

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the remaining accounting point information, wherein the
accounting center performs an accounting process based on the
remaining accounting point information transmitted from the
terminal device.

Claims 2-3 (Canceled).

Claim 4. The accounting system as claimed in claim 1,
wherein when the accounting point information stored in the
first memory is below a minimum for the first received
information stored in the second memory, the controller
performs control so that the attributes of the received
information are held in the unavailable state to a user.

Claim 5. The accounting system as claimed in claim 1,
wherein when the accounting point information stored in the
first memory is below a minimum for the received information
stored in the second memory, the second controller transmits
the accounting point information stored in the first memory to
the accounting center and sets the accounting point
information stored in the first memory at the initial value
based on the status of accounting processing corresponding to
the accounting point information.

Claim 6 (Canceled).

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Claim 7. The accounting system as claimed in claim 1, further comprising a third controller for making a request for purchasing the accounting point information to the accounting center and updating the accounting point information stored in the first memory based on the accounting processing status corresponding to the accounting point information received from the accounting center.

Claims 8-12 (Canceled).

9. EVIDENCE APPENDIX

There was no evidence submitted pursuant to 37 C.F.R 1.130, 1.131, or 1.132.

10. RELATED PROCEEDINGS AND APPENDIX

U.S. Application No. 09/923,702, filed August 7, 2001, being a divisional application of the instant application, is presently being appealed. A Notice of Appeal was filed on November 22, 2004 and an Appeal Brief was filed on February 22, 2005.